REMARKS

Claims 1-4 stand rejected under 35 U.S.C. § 112, first paragraph (enablement). This rejection is respectfully traversed for the following reasons. The Examiner alleges that the specification does not enable "the value obtained by dividing the count value of the half cycle of said reference clock by said multiplication factor is defined as a multiple count value." However, page 8, line 21 – page 9, line 1 of Applicants' specification clearly describes an exemplary embodiment of the present invention by which to obtain the multiple count value. For example, turning to the exemplary embodiment shown in Figure 1 of Applicants' drawings, the multiplication factor setting circuit 113 can calculate the multiple count value by the externally provided multiplication factor and the count value of the half cycle of the reference clock obtained by the claimed reference clock counter. It should be noted that "the multiple count value" defines a *condition* by which the multiple clock counter operates to perform the claimed inversion so that the structure creating the "the multiple count value" need not be claimed (e.g., "multiple count value" can be, for example, a signal external to the claimed elements).

The Examiner further alleges that the claimed function "inverts the multiple clock output each time it counts said multiple count value by the output clock of said ring oscillator" is not seen in the description of the preferred embodiment. However, page 9, lines 2-9 expressly describes one exemplary embodiment by which to perform the aforementioned limitation.

Based on the foregoing, it is submitted that claims 1-4 are enabled. Accordingly, it is respectfully requested that this rejection be withdrawn.

In addition, it is noted that the Examiner alleges that "the patentability [of the claims] cannot be determined because of failing to comply with the enablement requirement." It is respectfully submitted, however, that allegedly failing the enablement requirement does NOT preclude a

patentability determination over prior art. There is no uncertainty/confusion about the *interpretation* of the claim limitations. The Examiner merely alleges that the specification does not describe *how* those limitation can be performed. Indeed, the Examiner does not allege any such uncertainty/confusion regarding the *meaning* of the claims. As set forth throughout the MPEP, the Examiner is required to conduct a prior art search even when claims are deemed indefinite *or not supported by the specification* (*see, e.g.,* MPEP § 2143.03 under the headings "Indefinite Limitations Must Be Considered" and "Limitations Which Do Not Find Support in the Original Specification Must Be Considered", as well as MPEP § 2173.06). Accordingly, if the Examiner issues a prior art rejection in the next Office Action, it is respectfully requested that the Office Action be made non-final.

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph. It is respectfully submitted that the claims, as amended, are definite. Accordingly, it is respectfully requested that this rejection be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 RMF:MWE
Facsimile: 202.756.8087
Date: September 29, 2004